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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/397,494	09/15/1999	DAVID J. BALABAN	18547-037510	8817
33494	7590	05/21/2004	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW LLP TWO EMBARCADERO CENTER 8TH FLOOR SAN FRANCISCO, CA 94111-3834			WEST, JEFFREY R	
			ART UNIT	PAPER NUMBER
			2857	

DATE MAILED: 05/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/397,494	Applicant(s) BALABAN ET AL.	
	Examiner Jeffrey R. West	Art Unit 2857	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26-32 and 34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26-32 and 34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 26, 31, and 34 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 5,968,731 to Layne et al.

Layne discloses a method for a user interface to accept laboratory experiment information for control of a laboratory experiment (column 3, line 60 to column 4, line 9), the method using a computer system, the computer system including a processing system coupled to a network, wherein a user input device and processor are coupled to the processing system (column 8, lines 13-20 and Figure 5), the method comprising accepting signals from the user input device to define a parameter of an experiment (column 8, lines 27-30 and column 15, lines 58-33), transferring the parameter to the network (column 8, lines 27-30), receiving experiment results from the network, wherein the experiment results include results from an experiment using the parameter, and outputting the experiment results on the computer system (column 8, lines 34-37 and column 15, lines 38-40) via a coupled display device (column 11, lines 30-38).

Layne also discloses executing the method using computer program instructions embodied on a computer-readable medium (column 10, lines 4-17

Layne further discloses accepting signals from the user to indicate a target database for publishing experiment results (column 8, lines 38-41 and column 15, lines 40-41).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Layne et al. in view of U.S. Patent No. 4,875,859 to Wong et al.

As noted above, the invention Layne teaches many of the features of the claimed invention and while Layne does include software modules for describing, to the user, how to use the test instruments (column 10, lines 33-37) as well as for explaining how the test facility is used along with test methodology (column 11, lines 30-35), Layne does not specifically display steps of setup and execution of the experiment.

Wong teaches a method and apparatus for guiding a user during setup of a signal measurement system including a display for textually and pictorially presenting the steps of setup and execution to the user (column 1, lines 55-60).

It would have been obvious to one having ordinary skill in the art to modify the invention of Layne to include specifically displaying steps of setup and execution of the experiment, as taught by Wong, because, as suggested by Wong, the combination would have provided a method for insuring that the proper instruments are setup and necessary parameters are obtained in selecting the correct desired test/measurement process (column 2, lines 1-5 and column 4, line 55 to column 5, line 11).

5. Claims 26-31, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,100,030 to McCasky Feazel et al. in view of Layne et al.

McCasky Feazel discloses the use of selective DNA fragment amplification products for hybridization-based genetic fingerprinting, marker assisted selection, and high-throughput screening for use in a laboratory experiment (abstract) comprising accepting signals/input data from a user input device, through a computer interface, inherently with associated instructions (column 43, lines 27-38), to define a parameter of an experiment, including data to define a probe array image identifier (column 50, lines 42-49 and column 52, lines 54-62) and a probe array analysis set and type (i.e. experiment ID, sample ID, and plate type) (column 44, lines 10-35) by displaying setup prompts on a corresponding display (column 44, line 60 to column 45, line 3, column 45, lines 52-63, and column 44, lines 10-35).

McCasky Feazel also discloses exporting/transferring the received parameters to a processor to generate experimental results (column 44, lines 36-38) and display the

experimental results experiment/array images (column 53, lines 1-3), indicating hybridization information (column 3, lines 30-56), as well as displaying the current state of the experimental operation (column 49, lines 31-43). McCasky Feazel also discloses receiving from the user signals/data indicating a target output file (column 46, lines 3-18).

While McCasky Feazel does describe producing and exporting a target output file, McCasky Feazel does not specifically disclose conducting the experiment over a network (i.e. transferring parameters to a network and receiving experiential results from the network).

Layne discloses a method for a user interface to accept laboratory experiment information for control of a laboratory experiment (column 3, line 60 to column 4, line 9), the method using a computer system, the computer system including a processing system coupled to a network, wherein a user input device and processor are coupled to the processing system (column 8, lines 13-20 and Figure 5), the method comprising accepting signals from the user input device to define a parameter of an experiment (column 8, lines 27-30 and column 15, lines 58-33), transferring the parameter to the network (column 8, lines 27-30), receiving experiment results from the network, wherein the experiment results include results from an experiment using the parameter, and outputting the experiment results on the computer system (column 8, lines 34-37 and column 15, lines 38-40) via a coupled display device (column 11, lines 30-38).

Layne also discloses executing the method using computer program instructions embodied on a computer-readable medium (column 10, lines 4-17

Layne further discloses accepting signals from the user to indicate a target database for publishing experiment results (column 8, lines 38-41 and column 15, lines 40-41).

It would have been obvious to one having ordinary skill in the art to modify the invention of McCasky Feazel to include conducting the experiment over a network, as taught by Layne, because, as suggested by Layne, the combination would have provided a method for allowing access to biological samples in areas where access to laboratory materials and procedures is limited (column 8, lines 1-12) as well as provide means for linking the process to additional information and/or additional users to allow more through analysis by sharing samples (column 8, lines 38-43 and column 10, line 64 to column 11, line 11).

Response to Arguments

6. Applicant's arguments with respect to claims 26-32 and 34 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

U.S. Patent No. 6,289,352 to Proctor teaches an apparatus and method for compound on-line analytical processing in databases.

U.S. Patent No. 5,946,471 to Voorhees et al. teaches a method and apparatus for emulating laboratory instruments at remote stations configured by a network controller.

U.S. Patent No. 6,055,487 to Margery et al. teaches an interactive remote sample analysis system.

U.S. Patent No. 6,009,381 to Ono teaches a remote control measuring system that displays setup and execution instructions.

U.S. Patent No. 5,104,621 to Pfoest et al. teaches an automated multi-purpose analytical chemistry processing center and remote laboratory work station that displays setup and execution instructions.

U.S. Patent No. 4,949,290 to Pike et al. teaches a method and apparatus for defining test sequences for a signal measurement system.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey R. West whose telephone number is (703)308-1309. The examiner can normally be reached on Monday through Friday, 8:00-4:30.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marc S. Hoff can be reached on (703)308-1677. The fax phone numbers for the organization where this application or proceeding is assigned are

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(703)308-7382 for regular communications and (703)308-7382 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0956.

jrw
May 16, 2004


MARC S. HOFF
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800